

The rejection fails to establish a prime facie case of unpatentability.

The label "applicant's admitted prior art" is misleading and/or inaccurate. Page 1 of the specification merely describes the "Field of Invention". Moreover, it is not clear which sentence or part of specification page 1 is being relied on. The designation page 1, lines 1 *et seq.* does not specify which part or sentence is being relied on.

Applicant respectfully traverses that page 1, lines 1 *et seq.* constitutes "applicant's admitted prior art".

Furthermore, it is clear that it is not contended that Stacey alone makes the rejected claims obvious. Therefore, the teachings of Stacey and Thanawala are combined in an attempt to allege obviousness of the rejected claims.

However, it is also clear that it is not contended that the combination of Stacey and Thanawala alone makes obvious the rejected claims. Thus, the rejection finds the need to combine the teachings of Stacey and Thanawala with the teaching of some unidentified portion of applicant's page 1, lines 1 *et seq.*

In contrast, applicant respectfully submits that if the prior art provides no teaching, suggestion or incentive supporting the combination proposed by the Examiner, then the rejection is in error and must be reversed. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990).

Obvious to try, or obvious to test or experiment, is not a proper standard of patentability. "Selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from applicant's disclosure." *In re Dow Chemical Co*, 837 F2d 469, 5 USPQ2d 1529, 1532 (CAFC 1988).

"To imbue one of ordinary skill in the art with knowledge of the invention... when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates Inc. v Garlock Inc.*, 721 F2d 1540, 1553, 220 USPQ 303, 312-13 (CAFC 1983).

Notwithstanding the foregoing, the Office Action states that "In this case, the examiner provided the motivations for combining the references as cited in the previous office action...." It is respectfully submitted that there is no proper authority for permitting the Examiner to provide the motivations for combining the references cited.

It is improper to use hindsight, after having read applicant's patent application, to determine patentability. In the present case, the rejected claims are alleged to be unpatentable based on a combination of prior art references, some unspecified portion of applicant's specification page 1, and the motivations for combining the foregoing coming from the Examiner after having read the present patent application.

It is also improper hindsight merely to "pick and chose" components from the prior art references to arrive at the claimed invention. There should be a suggestion in the prior art references to combine the components as recited in the claimed invention. Without this suggestion, the alleged obviousness rejection is improper.

The Office Action further alleges that claims 22, 26, 29 and 39, despite a slight difference in wording, essentially repeat the limitations as cited in appealed claims 1-11 and 20-21. The Examiner further contends "Note the specifics of the three passive electrical components which are tuned to the third harmonic frequency are recited in appealed claims 2 and 4." Applicant respectfully traverses these contentions.

Appealed claims 1-6 require "a first passive electrical component connected along a phase line in said electrical system in series with at least one of said nonlinear loads", whereas present claims 22, 29 and 39 do not.

Appealed claims 1-6, 20 and 21 require "to substantially eliminate a harmonic current drawn by said at least one nonlinear load connected in series with said parallel connections of said first, said second, and said third passive electrical components", whereas present claims 22, 26 and 39 do not.

Furthermore, present claims 22 and 26 require "a first completely-passive parallel resonant circuit," whereas appealed claims 1-6, 20 and 21 do not.

The foregoing distinctions apply with even greater force to present claim 26 which depends from present claim 22. In addition, present claim 26 requires "a second completely-passive parallel resonant circuit and a third completely-passive parallel resonant circuit," whereas the appealed claims do not.

Present claim 29 requires "a completely-passive parallel resonant circuit" which "comprises three completely-passive electrical branches," whereas the appealed claims do not.

Present claim 39 requires "a completely-passive parallel resonant circuit" which "comprises three completely-passive electrical branches" and "a housing member for said completely-passive parallel resonant circuit and means for connecting the nonlinear load to said completely-passive parallel resonant circuit", whereas the appealed claims do not.

Moreover, the above-quoted features of applicant's present claims are not found in the Stacey reference, or in the Thanawala reference, or in the unspecified portion of applicant's specification page 1, taken singly or in combination, with or without the Examiner's motivations for combining the cited references.

For a rejection to be proper under Section 103, the subject matter as a whole must have been obvious to a person having ordinary skill in the art to which the invention pertains. Thus, it is necessary to determine the level of ordinary skill in the relevant art. This, the Examiner has failed to do.

Factors pertinent to evaluating the level of ordinary skill include: the type of problems encountered in the art; the prior art solutions to those problems; the rapidity with which innovations are made in the art; the sophistication of the technology; and the educational level of workers active in the field. *Environmental Design Ltd. v Union Oil Co. of California*, 713 F.2d 693, 218 USPQ 865 (CAFC 1983).

This level of skill is not the skill possessed by a judge, or a layman, or by those skilled in remote fields of endeavor, or by Patent Examiners, or by geniuses in the field. The person of ordinary skill is a hypothetical, de jure person who is presumed by law to be aware of all the pertinent prior art. The actual inventor's skill is not determinative.

These and other considerations are all relevant to determining the level of ordinary skill in the relevant art. Once that level has been determined, there are still other factors ("secondary" considerations) that must be evaluated before it is at last possible to proceed to the final determination, i.e., the obviousness or nonobviousness of the invention.

The Supreme Court has held that such "secondary considerations as commercial success, long felt but unsolved needs, failures of others" and other similar matters, when present, must be employed to illuminate the circumstances surrounding the origin of the invention sought to be patented and may have relevancy as indicia as to the obviousness or nonobviousness of that invention.

In this connection, applicant has already filed on March 30, 2001 a Declaration Re Commercial Success And Acclaim by the inventor, Michael Z. Lowenstein.

Applicant submits herewith the corroborative Declarations by Rudolph J. Kraus and William J. Pirrone in support of the secondary considerations mentioned herein.

These "secondary" considerations are by no means secondary in importance. *Truswal Systems Corp. v Hydro-Air Engineering, Inc.*, 813 F.2d 1207, 2 USPQ2d 1034 (CAFC 1987). Rather, they are "secondary" in sequence. Objective evidence of these secondary considerations is often the most persuasive factors because it forestalls hindsight analysis. *Cable Electric Products, Inc. v Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (CAFC 1985).

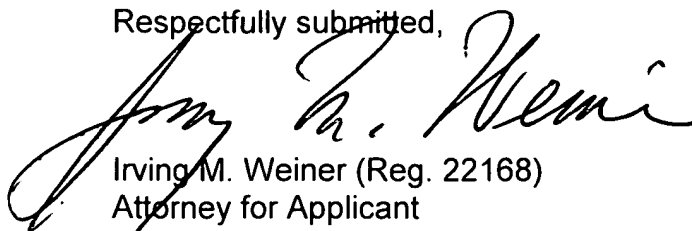
In light of the foregoing, applicant respectfully requests that the Examiner reconsider the obviousness rejection with a view toward withdrawing same.

It is respectfully submitted that the application is now in condition for allowance, and a notice to this effect is earnestly solicited.

The applicant also encloses herewith a Petition for Extension of Time under 37 CFR 1.136(a) with the required extension fee.

Favorable consideration respectfully requested.

Respectfully submitted,

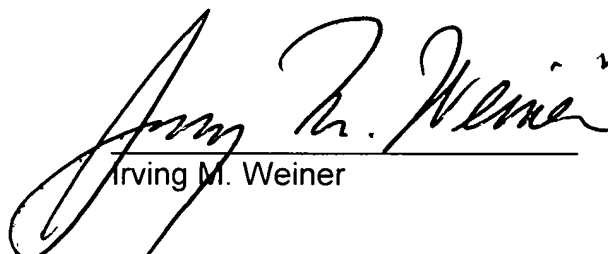


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I hereby certify that the foregoing amendment with its mentioned attachments were sent to Box Non-Fee Amendment, Commissioner for Patents, Washington, D.C. 202331 on August 22, 2001 by first class mail.



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